



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

②

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,846	09/17/2001	Y. Tom Tang	PF-0556-1 DIV	9384
27904	7590	04/08/2004	EXAMINER LI, RUIXIANG	
INCYTE CORPORATION 3160 PORTER DRIVE PALO ALTO, CA 94304			ART UNIT 1646	PAPER NUMBER

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b> 09/954,846	<b>Applicant(s)</b> TANG ET AL.	
	<b>Examiner</b> Ruixiang Li	<b>Art Unit</b> 1646	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED on 3/22/2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 4,5 and 46.

Claim(s) rejected: 3,6,7,9,11 and 12.

Claim(s) withdrawn from consideration: 8,13-17,19,20 and 24-28.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 2. NOTE: Amended claim 11 recites "and which encodes a polypeptide having thioredoxin activity". It is unclear which nucleotide sequence is being modified by this limitation, rendering the claim indefinite. Similarly, claim 12 is indefinite because it recites "and which may be used to detect the complete complement of a polynucleotide of claim 11".

Continuation of 5. does NOT place the application in condition for allowance because: the rejection of claims 11 and 12 under 35 U.S.C. 112, 1st paragraph for enablement and written description remains. It is noted that claims 11 and 12 have been amended by adding a functional limitation. However, such an amendment causes the claims to be indefinite as noted above. If the functional limitation were properly added to the claims, the rejection of claims 11 and 12 under 35 U.S.C. 112, 1st paragraph would have been overcome.

If the amendment were entered, the rejection of claims 3, 6, 7, and 9 under 35 U.S.C. 112, 1<sup>st</sup> paragraph for scope of enablement and written description would have been overcome.

An improper use of an article "a" is noted in the newly added functional limitation to claim 3 (line 11); "a polypeptide of SEQ ID NO: 2" should be "the polypeptide of SEQ ID NO: 2". Similarly, "a" should also be replaced by "the" in claim 11 (line 3, "...comprising a polynucleotide sequence of SEQ ID NO: 4; line 5, "...identical to a polynucleotide sequence of SEQ ID NO: 4").

  
**GARY KUNZ**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**